

REMARKS

This responds to the Office Action dated on November 1, 2007.

Claims 1, 12, 15, 18 and 28 are amended, no claims are canceled, and no claims are added. Thus, claims 1-7 and 9-30 remain pending in this application.

The specification has been amended to correct a typographical error. Applicant respectfully submits that no new matter was added in making this amendment to the specification.

§101 Rejection of the Claims

Claims 1-7 and 9-30 were rejected under 35 U.S.C. § 101 because the Office Action asserts that the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility. Applicant respectfully traverses the rejection for at least the following reasons.

The Office Action states, in the “response to arguments” section that “being simple and compatible with many known controllers and implantable devices does not explain the circuitry elements” and “merely stating the purpose of a controller and switch does (not) provide sufficient specifics to enable one of ordinary skill in the art to construct the circuitry.” Applicant submits that the specification does provide specifics to enable one of skill in the art to construct the circuitry. Specifically, the specific function of circuitry elements ‘controller’ and ‘switch’ are described with reference to circuits shown in FIGS. 3-5. At page 7, line 28 to page 8, line 2, for example, specific details are provided with respect to controller and switch operation: “(i)n operation, controller 260 may activate switch 262 via control line C to connect battery voltage source 228 to amplifier 264 to increase (power up) the effective voltage provided to inductive coil 222.” In addition, at page 7, lines 11-16: “(t)he switch 162 includes an input line A from the first voltage source 128, an input line B from the second voltage source 124, and a non-connect line (NC). The switch 162 is controlled by controller 160 via control line C to facilitate the combination of voltages from first and second battery voltage sources 128, 124 to generate a greater effective voltage output ($V_{B1} + V_{B2}$) for powering inductive coil 122.”

Applicant respectfully submits that one of ordinary skill in the art would be able to construct the controllers to enable the function of controlling, without undue experimentation.

Thus, the Applicant respectfully submits that the claimed invention is supported by a specific and substantial asserted utility in addition to a well established utility. In the previous response Applicant requested that, should this rejection be maintained, authority should be provided to support the Office's interpretation with respect to §101. No such authority has been cited. Applicant respectfully renews the request.

Applicant respectfully requests withdrawal of the §101 rejection of the claims.

§112 Rejection of the Claims

Claims 1-7 and 9-30 were rejected under 35 U.S.C. § 112, first paragraph. Applicant respectfully traverses. With respect to this rejection, the Applicant refers to the discussion above with respect to the §101 rejection of the claims. Based at least on the specification citations made in that discussion, Applicant respectfully asserts that one of skill in the art would know how to use the claimed invention. Applicant respectfully requests withdrawal of the rejection, and reconsideration and allowance of claims 1-7 and 9-30.

§102 Rejection of the Claims

Claims 12, 15 and 18 were rejected under 35 U.S.C. § 102(b) as being anticipated by Itoga et al. (U.S. Patent No. 5,122,729, "Itoga"). Applicant respectfully traverses the rejection for at least the following reasons.

Applicant respectfully asserts that the rejection has not provided a *prima facie* case for anticipation, as the rejection has not applied the reference against the language of the claims. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Should the §102 rejection be maintained, Applicant respectfully requests the Examiner to apply the references against the language in the claims, and to identify the page and line numbers

and/or the figure and reference numbers of the references relied upon to make the rejection for each claim limitation.

The Office Action states, “(t)he examiner is interpreting the detection coil 12 to be capable of detecting ‘data’ from the secondary coil 7 comprising changes in induced voltage resulting from changes in distance between the primary coil 3 and the secondary coil 7.” Applicant respectfully submits that sensing or detecting a voltage (and thus a distance between coils, as disclosed in Itoga) is not “communicating data with inductive telemetry.”

Applicant has amended claims 12, 15 and 18 to further clarify the recited subject matter. Support for the amendment is provided at least at page 4, lines 21-22 of the specification. Applicant respectfully submits that “sensing” or “detecting” a distance between (or relative placement of) coils using an analog feedback loop is not “transmitting data.” In addition, the cited reference does not show a controller programmed to control a coil to transmit data. Thus, Applicant respectfully submits that Itoga does not teach a “telemetry coil” as claimed in the present application.

With respect to independent claim 12, Applicant is unable to find among other things in the cited portion of Itoga, a circuit for a wireless handheld device configured for communicating data with inductive telemetry, including a telemetry coil driven by the first battery voltage source and controllable by the controller to transmit and receive data to and from a second device using inductive telemetry, as recited in amended claim 12.

With respect to independent claim 15, Applicant is unable to find among other things in the cited portion of Itoga, a method of powering a handheld device configured for communicating data with a second device using inductive telemetry, including activating the telemetry coil in the handheld device to facilitate inductive telemetry for transmitting and receiving data to and from the second device, as recited in amended claim 15.

With respect to independent claim 18, Applicant is unable to find, among other things in the cited portion of Itoga, a method of powering a handheld device having a controller, a telemetry coil, and at least one battery providing a battery voltage, the method including transmitting and receiving data to and from an implanted device using inductive telemetry, as recited in amended claim 18.

Reconsideration and allowance of claims 12, 15 and 18 are respectfully requested.

§103 Rejection of the Claims

Claims 1, 2, 4, 11, 16, 22, 23, 24, 25, 26, 27, 28 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Itoga. Applicant respectfully traverses the rejection for at least the following reasons.

Prima facie obviousness requires a teaching that all elements of the claimed invention are found in the prior art and a reason that would have prompted a person of ordinary skill in the art in the relevant field to modify the prior art to arrive at the claimed invention. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007). All elements of the claims are not found in the rejection. In addition, the Office Action does not provide basis for the §103 rejection of individual claims. Only an implanted device and a switch are mentioned. Features from many of the dependent claims, such as voltage reducing device of claim 11 for example, are not identified. The rejection must show that the reference(s) show or suggest all elements of all rejected claims. Pursuant to 37 C.F.R. §1.104(a)(2) and MPEP 707.07(d), Applicant respectfully requests that the Office clearly identify the portion of the reference(s) relied upon for this subject matter, so that Applicant can judge the propriety of continuing the prosecution.

Applicant has amended claims 1 and 28 to further clarify the recited subject matter. Support for the amendment is provided at least at page 4, lines 21-22 of the specification. Applicant is unable to find, among other things in the cited portion of Itoga, a handheld device configured to communicate data with an implanted device using inductive telemetry, including a battery powered controller and a battery powered telemetry coil controlled by the controller and configured to transmit and receive data to and from a telemetry coil of the implanted device using inductive telemetry, as recited in amended claim 1. Claims 2, 4 and 11 depend, either directly or indirectly, on independent claim 1, and are believed to be in condition for allowance at least for the reasons provided with respect to claim 1.

Claims 22 and 23 depend on independent claim 12, and are believed to be in condition for allowance at least for the reasons provided with respect to claim 12. Claims 16 and 24-26 depend, either directly or indirectly, on independent claim 15, and are believed to be in condition for allowance at least for the reasons provided with respect to claim 15. Claim 27 depends on

independent claim 18, and is believed to be in condition for allowance at least for the reasons provided with respect to claim 18.

Applicant is unable to find, among other things in the cited portion of Itoga, a handheld device configured to communicate data with an implanted device using inductive telemetry, including a battery powered controller and a battery powered telemetry coil controlled by the controller and configured to transmit and receive data to and from a telemetry coil of the implanted device using inductive telemetry, as recited in claim 28. Claim 30 depends on independent claim 28, and is believed to be in condition for allowance at least for the reasons provided with respect to claim 28.

Since all the elements of the claims are not found in the reference, Applicant assumes that the Examiner is taking Official Notice of the missing elements. Applicant respectfully objects to the taking of Official Notice with a single reference obviousness rejection and, pursuant to M.P.E.P. § 2144.03, Applicant respectfully traverses the assertion of Official Notice and requests that the Examiner cite references in support of this position.

Applicant respectfully traverses the assertion that one of skill in the art would have found it obvious to use the teaching of Itoga with an implanted device. Itoga does not provide any suggestion that its power supply device with voltage sensing would function with a device implanted within human tissue. In addition, Applicant respectfully traverses the assertion that one of skill in the art would have found it obvious to provide a switch to control current in Itoga. Further, the switch disclosed in the present subject matter is used to connect a power source to a telemetry coil, and applicant cannot find a telemetry coil in Itoga.

Applicant respectfully requests withdrawal of the rejection, and reconsideration and allowance of claims 1, 2, 4, 11, 16, 22-28 and 30.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.116 – EXPEDITED PROCEDURE

Serial Number: 10/758,832

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Title: TELEMETRY FOR A BATTERY OPERATED DEVICE

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Dkt: 279.B36US1

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (715) 824-5144 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date January 31, 2008

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 31 day of JANUARY 2008.

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